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UNITED STATES DISTRICT COURT  
CENTRAL DISTRICT OF CALIFORNIA

ROMO DIMAS, et al.,	)	Case No. CV 13-08840 DDP (ASx)
	)	
Plaintiff,	)	<b>ORDER GRANTING IN PART</b>
	)	<b>PLAINTIFFS' MOTION FOR SUMMARY</b>
v.	)	<b>JUDGMENT</b>
	)	
TAPIA MATILDE, et al.,	)	[Dkt. No. 22]
	)	
Defendants.	)	
	)	

Presently before the Court is Plaintiffs Alfredo Romo Dimas, Ignacio Romo Dimas, Juan Luis Romo Dimas, Rogelio Romo Dimas, Guillermo Romo Dimas, and Gilberto Romo Dimas (collectively, "Plaintiffs")'s Motion for Summary Judgment ("MSJ"). (Docket No. 22.) Defendants Favian Tapia Matilde ("Matilde") and Delia Tapia (collectively, "Defendants") have not filed an opposition. Having reviewed Plaintiffs' submissions and heard oral argument, the Court GRANTS Plaintiffs' motion as to the federal trademark infringement claim and the cancellation of Defendants' trademark, and adopts the following order.

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1   **I.   BACKGROUND**

2           Plaintiffs are brothers and members of the musical group  
3   Samuray, which Plaintiffs founded in Mexico in 1990. (Declaration  
4   of Alfredo Romo Dimas ("Dimas Decl."), Docket No. 22-2, ¶ 2. As  
5   director of the group Samuray, Plaintiff Alfredo Romo Dimas  
6   ("Alfredo") registered the service mark "SAMURAY" in International  
7   Class 41 with the United States Patent and Trademark Office  
8   ("USPTO") on October 23, 2012.<sup>1</sup> (Plaintiffs' Separate Statement of  
9   Uncontroverted Facts and Conclusions of Law ("SUF"), Docket No. 22-  
10   28, ¶¶ 1, 5; Dimas Decl. Ex. 1.) Plaintiffs have used the SAMURAY  
11   mark in connection with their musical group and the performances of  
12   their musical group continuously since 1990. (SUF ¶¶ 2-4.)  
13   Plaintiffs have used the SAMURAY mark in commerce in the United  
14   States as early as 1991. (Id. ¶ 3.) Plaintiffs first use the  
15   SAMURAY mark in commerce in connection with goods (namely, records  
16   and CDs) as early as 1992, and have done so continuously since  
17   1992. (Id. ¶¶ 8-9.) Plaintiffs have released at least 15  
18   different albums of recordings from 1992 through 2014. (Id. ¶ 10;  
19   Dimas Decl. ¶ 7, Ex. 4-18.)

20           The packaging of Samuray's albums and promotional materials  
21   typically displays the name "SAMURAY" in distinctive font with a  
22   round symbol behind the word. (SUF ¶¶ 16-17.) Samuray performs a  
23   genre of Mexican music that is known as "romantico" or a "romantic"  
24   style. (Id. ¶ 18.) Oftentimes the group is promoted with the

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27           <sup>1</sup> This order uses "Samuray" to refer to the musical group,  
28   while it uses "SAMURAY" in capital letters to refer to Plaintiffs'  
  registered service mark.

1 nickname "los guerreros del amor," or "the warriors of love." (Id.  
2 ¶¶ 20-21.)

3 In 2009, Defendant Matilde filed an "intent to use"  
4 application to register the trademark "EL ROMANTICO SAMURAY" in  
5 international class 9, in connection with goods, including records  
6 and CDs. (Id. ¶ 24.) In response to requests from the USPTO,  
7 Matilde created three exhibits demonstrating the EL ROMANTICO  
8 SAMURAY mark. (Id. ¶ 28.) These exhibits were created solely to  
9 present to the USPTO and were never produced or used commercially.  
10 (Id.) In 2012, Matilde filed a trademark application for "EL  
11 ROMANTICO SAMURAY" as a service mark in international class 41.  
12 (Id. ¶ 37.)

13 Matilde first learned of the existence of the Samuray musical  
14 group in 1990. (Id. ¶ 22.) Matilde has a musical group that plays  
15 songs by Samuray (otherwise known as "covers"). (Id. ¶ 23.)  
16 Matilde began using the EL ROMANTICO SAMURAY mark in January 2010.  
17 (Id. ¶ 39.) Matilde's El Romantico Samuray group plays live music  
18 and distributes recordings. (Id. ¶¶ 49-50.) On multiple  
19 occasions, performances by Matilde's El Romantico Samuray group  
20 have been advertised as Plaintiffs' Samuray group, including using  
21 visual ads that depict the members of the Samuray group accompanied  
22 by a Samuray logo. (Id. ¶¶ 51-53.)

23 On November 27, 2013, Plaintiffs filed the present action  
24 against Defendants, alleging claims for (1) federal trademark  
25 infringement and unfair competition, (2) trademark infringement  
26 under California common law, (3) unfair competition under Cal. Bus.  
27 and Prof. Code §§ 17200 et seq., (4) false advertising under Cal.  
28 Bus and Prof. Code §§ 17500 et seq., (5) interference with

1 prospective business advantage, (6) cancellation of registration of  
2 trademark, (7) accounting, and (8) injunctive relief. (Docket No.  
3 1.) Defendants filed an Answer. (Docket No. 10.) Plaintiffs have  
4 now moved for summary judgment. (Docket No. 22.) Defendants have  
5 not filed an opposition.

## 6 **II. LEGAL STANDARD**

7 Summary judgment is appropriate where the pleadings,  
8 depositions, answers to interrogatories, and admissions on file,  
9 together with the affidavits, if any, show "that there is no  
10 genuine dispute as to any material fact and the movant is entitled  
11 to judgment as a matter of law." Fed. R. Civ. P. 56(a). A party  
12 seeking summary judgment bears the initial burden of informing the  
13 court of the basis for its motion and of identifying those portions  
14 of the pleadings and discovery responses that demonstrate the  
15 absence of a genuine issue of material fact. See Celotex Corp. v.  
16 Catrett, 477 U.S. 317, 323 (1986). All reasonable inferences from  
17 the evidence must be drawn in favor of the nonmoving party. See  
18 Anderson v. Liberty Lobby, Inc., 477 U.S. 242, 242 (1986). If the  
19 moving party does not bear the burden of proof at trial, it is  
20 entitled to summary judgment if it can demonstrate that "there is  
21 an absence of evidence to support the nonmoving party's case."  
22 Celotex, 477 U.S. at 323.

23 Once the moving party meets its burden, the burden shifts to  
24 the nonmoving party opposing the motion, who must "set forth  
25 specific facts showing that there is a genuine issue for trial."  
26 Anderson, 477 U.S. at 256. Summary judgment is warranted if a  
27 party "fails to make a showing sufficient to establish the  
28 existence of an element essential to that party's case, and on

1 which that party will bear the burden of proof at trial." Celotex,  
2 477 U.S. at 322. A genuine issue exists if "the evidence is such  
3 that a reasonable jury could return a verdict for the nonmoving  
4 party," and material facts are those "that might affect the outcome  
5 of the suit under the governing law." Anderson, 477 U.S. at 248.  
6 There is no genuine issue of fact "[w]here the record taken as a  
7 whole could not lead a rational trier of fact to find for the  
8 nonmoving party." Matsushita Elec. Indus. Co. v. Zenith Radio  
9 Corp., 475 U.S. 574, 587 (1986).

10 It is not the court's task "to scour the record in search of a  
11 genuine issue of triable fact." Keenan v. Allan, 91 F.3d 1275,  
12 1278 (9th Cir.1996). Counsel has an obligation to lay out their  
13 support clearly. Carmen v. San Francisco Sch. Dist., 237 F.3d  
14 1026, 1031 (9th Cir.2001). The court "need not examine the entire  
15 file for evidence establishing a genuine issue of fact, where the  
16 evidence is not set forth in the opposition papers with adequate  
17 references so that it could conveniently be found." Id.

### 18 **III. DISCUSSION**

#### 19 **A. Trademark Infringement under the Lanham Act**

20 Plaintiffs assert a trademark infringement claim under Section  
21 43(a) of the Lanham Act. 15 U.S.C. § 1125(a)(1)(A). "To establish  
22 a trademark infringement claim," a plaintiff must show (1) it has  
23 valid, protectable trademarks, and (2) that defendant's use of the  
24 marks is likely to cause confusion. Applied Info. Sciences Corp.  
25 v. eBay, Inc., 511 F.3d 966, 969 (9th Cir. 2007).

##### 26 1. Ownership of the Mark

27 "It is axiomatic in trademark law that the standard test of  
28 ownership is priority of use. To acquire ownership of a trademark

1 it is not enough to have invented the mark first or even to have  
2 registered it first; the party claiming ownership must have been  
3 the first to actually use the mark in the sale of goods or  
4 services." Sengoku Works Ltd. v. RMC Int'l, Ltd., 96 F.3d 1217,  
5 1219 (9th Cir. 1996). "The first to use a mark is deemed the  
6 'senior' user and has the right to enjoin 'junior' users from using  
7 confusingly similar marks in the same industry and market or within  
8 the senior user's natural zone of expansion." Brookfield Commc'ns.  
9 Inc. V. West Coast Entm't Corp., 174 F.3d 1036, 1047 (9th Cir.  
10 1999).

11 Plaintiffs have presented evidence that they are the senior  
12 user of the SAMURAY mark. They have used the SAMURAY name and mark  
13 continuously since 1990 for the purposes of their musical  
14 recordings and performances. Matilde first filed a trademark  
15 application for EL ROMANTICO SAMURAY in 2009. At deposition,  
16 Matilde testified that he did not begin using his EL ROMANTICO  
17 SAMURAY mark in conjunction with his performances until 2010.  
18 Therefore, although Matilde first registered a trademark using the  
19 "SAMURAY" name, Plaintiffs were the first to use the SAMURAY mark  
20 in commerce. See Brookfield, 174 F.3d at 1047 (stating that,  
21 although a registration of a mark with the USPTO constitutes prima  
22 facie evidence of a mark's validity, the presumption can be  
23 rebutted by a party showing that he first used the mark in  
24 commerce).

## 25 2. Likelihood of Confusion

26 Beyond ownership, the "core element" of a trademark  
27 infringement claim is the likelihood that the similarity of the  
28 marks will confuse consumers as to the source of goods or services.

1 Freecycle Network, Inc. v. Oey, 505 F.3d 898, 902 (9th Cir. 2007).  
2 Relevant factors include the strength of the mark, proximity of the  
3 goods, similarity of the marks, evidence of actual confusion,  
4 marketing channels used, degree of care likely to be exercised by  
5 consumers, defendant's intent, and likelihood of expansion of  
6 product lines. AMF Inc. v. Sleekcraft Boats, 599 F.2d 941, 348-49  
7 (9th Cir. 1979). It is unnecessary to meet every factor, because  
8 the likelihood of confusion test is "fluid". Surfvivor Media, Inc.  
9 v. Survivor Prods., 406 F.3d 625, 631 (9th Cir. 2005).

10 The strength of a trademark depends, in part, on its position  
11 on a spectrum ranging from generic to arbitrary. Rearden LLC v.  
12 Rearden Commerce, Inc., 683 F.3d 1190, 1211 (9th Cir. 2012).  
13 Arbitrary marks consist of words that have no connection with the  
14 product. Id. Here, "SAMURAY," a Spanish word meaning "samurai,"  
15 has nothing to do with a musical group that performs traditional  
16 Mexican romantic music. Accordingly, Plaintiffs' mark is strong.

17 On balance, the Court finds that there is a high likelihood of  
18 confusion. Although the alleged infringing mark is different from  
19 Plaintiffs' mark -- Matilde's mark adds the modifier "EL ROMANTICO"  
20 to the word "SAMURAY" -- the strength of the mark, the proximity of  
21 the use of the marks, their similarity, and evidence of actual  
22 confusion all weigh in favor of finding likelihood of confusion.  
23 Both marks use the distinctive word "SAMURAY." Both musical groups  
24 perform similar music -- in fact, Matilde stated that his EL  
25 ROMANTICO SAMURAY group would play covers of Samuray songs. Both  
26 musical groups perform in similar venues. In fact, Alfredo  
27 discovered Matilde's group because his Samuray group was losing  
28 booking venues to the El Romantico Samuray group. (Dimas Decl. ¶¶

1 17, 20.) Alfredo spoke with one promoter who thought he had booked  
2 the Samuray group, but only upon investigation discovered he had  
3 booked the El Romantico Samuray group. (Id. ¶ 20.) Finally,  
4 because Plaintiffs' mark is arbitrary because it is non-  
5 descriptive, it is awarded "maximum protection." E. & J. Gallo  
6 Winery v. Gallo Cattle Co., 967 F.2d 1280, 1291 (9th Cir. 1992)  
7 (holding that an "arbitrary" mark is "awarded maximum protection").  
8 See also Official Airline Guides, Inc. v. Goss, 6 F.3d 1385, 1390  
9 (9th Cir. 1993) ("An arbitrary mark consists of common words  
10 arranged in an arbitrary way that is non-descriptive of any quality  
11 of the goods or services.").

12 For the reasons stated above, the Court finds that there is a  
13 substantial likelihood of confusion.

### 14 3. Conclusion

15 The Ninth Circuit has recognized that "[b]ecause of the  
16 intensely factual nature of trademark disputes, summary judgment is  
17 generally disfavored in the trademark arena." Rearden LLC v.  
18 Rearden Commerce, Inc., 683 F.3d 1190, 1209 (9th Cir. 2012). "We  
19 have cautioned that district court should grant summary judgment  
20 motions regarding the likelihood of confusion sparingly, as careful  
21 assessment of the pertinent factors that go into determining  
22 likelihood of confusion usually requires a full record." Id.  
23 Given the evidence Plaintiffs have presented in this case, however,  
24 paired with the fact that Defendants have failed to file an  
25 opposition brief, the Court concludes that Plaintiffs are entitled  
26 to summary judgment on their trademark infringement claim.

27 Plaintiffs have requested that the Court grant a permanent  
28 injunction granting relief against future infringement by

1 Defendants. When summary judgment has been granted on a trademark  
2 infringement claim, court may grant a permanent injunction without  
3 a specific hearing on the issue. Phillip Morris USA Inc. v.  
4 Shalabi, 352 F. Supp. 2d 1067, 1074 (C.D. Cal. 2004). Given the  
5 irreparable harm Plaintiffs may suffer if injunctive relief is not  
6 granted, combined with the interest in protecting consumers from  
7 confusion, the Court will grant Plaintiff's request for injunctive  
8 relief. See Metro Pub., Ltd. v. San Jose Mercury News, 987 F.2d  
9 637, 640 (9th Cir. 1993) ("Once the plaintiff has demonstrated a  
10 likelihood of confusion, it is ordinarily presumed that the  
11 plaintiff will suffer irreparable harm if injunctive relief is not  
12 granted.").

#### 13 **B. Trademark Cancellation**

14 Plaintiffs also move the Court to cancel Defendants' EL  
15 ROMANTICO SAMURAY trademark, arguing that Defendants obtained the  
16 registration by fraud. To obtain cancellation of a trademark, a  
17 party must show: "(1) a false representation regarding a material  
18 fact; (2) the registrant's knowledge or belief that the  
19 representation is false; (3) the registrant's intent to induce  
20 reliance upon the misrepresentation; (4) actual, reasonable  
21 reliance on the misrepresentation; and (5) damages proximately  
22 caused by that reliance." Hokto Kinoko Co. v. Concord Farms, Inc.,  
23 738 F.3d 1085, 1097 (9th Cir. 2013).

24 Here, Plaintiffs contend that Matilde made a false  
25 representation to the USPTO when he created and submitted specimens  
26 with his trademark application that "were fakes that he created for  
27 the sole purpose of inducing the USPTO to issue him" the EL  
28 ROMANTICO SAMURAY mark. (MSJ at 16.) Plaintiffs have also

1 produced evidence that shows Matilde not only was aware of the  
2 Samuray group, but also played covers of Samuray songs. (SUF ¶¶  
3 22-23.) Matilde has not filed an opposition. Based on the  
4 evidence on the record, the Court finds that Plaintiffs are  
5 entitled to summary judgment on their cancellation claim.

6 **C. Plaintiffs' Other Claims**

7 Although Plaintiffs seemingly move for summary judgment on all  
8 of their claims, their MSJ only addresses the claims for federal  
9 trademark infringement, cancellation, and injunctive relief.  
10 Plaintiffs' MSJ does not address their other claims, including  
11 their state law claims. Plaintiffs clarified at the hearing on  
12 this motion that they would not pursue the other claims.  
13 Accordingly, the Court will consider those claims abandoned.

14 **IV. CONCLUSION**

15 The Court GRANTS summary judgment in favor of Plaintiffs on  
16 their claims for federal trademark infringement and cancellation of  
17 Defendants' trademark. The Court further GRANTS Plaintiffs'  
18 request for injunctive relief. The Court permanently enjoins and  
19 restrains Defendants Favian Tapia Matilde, Delia Tapia and their  
20 respective officers, agents, servants, employees, and attorneys,  
21 and other persons who are in active concert or participation with  
22 any of the aforementioned persons from using the SAMURAY service  
23 mark, or any confusingly similar or colorable imitation of the  
24 mark, in any manner in connection with the sale, advertising,  
25 offering, announcing or promotion of musical services, such as live

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1 performances of a musical group, or products, such as phonograph  
2 records, CDs, DVDs or their digital counterparts.

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4 IT IS SO ORDERED.

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7 Dated: September 30, 2015

A handwritten signature in blue ink, reading "Dean D. Pregerson". The signature is fluid and cursive, with the first name "Dean" and last name "Pregerson" clearly legible.

DEAN D. PREGERSON  
United States District Judge

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